Remarks

Prior to this Amendment, claims 1-30 were pending in the present application. By this Amendment, Applicant has amended claims 1-7, 11, 13-23, and 27-29. No new matter was added by this Amendment. Applicant respectfully requests reexamination and reconsideration of the pending claims in view of the amendments and remarks contained herein.

I.   Claim Rejections – 35 U.S.C. § 112, Second Paragraph

Claims 16-30 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Examiner alleged that claims 16 and 18 were indefinite because "the limitation 'creating a transaction data set' fails to relate or coincide with other limitations." Although Applicant finds "creating a transaction data set" to be a clear and definite limitation, in the interest of advancing prosecution, Applicant has amended claims 16 and 28 to call for "retrieving one or more cross-referenced document components from a data base based on the transaction data set," to overcome the rejection. Accordingly, Applicant respectfully requests the withdrawal of the 35 U.S.C. § 112, second paragraph rejections of claims 16 and 28.

II.   Claim Rejections – 35 U.S.C. § 102(b)

Claims 1, 12, and 13 stand rejected under 35 U.S.C § 102(e), as being anticipated by United States Patent No. 7,299,409 (hereinafter referred to as "Joshi"). As discussed below, Joshi does not teach or suggest the subject matter defined by these claims.

Joshi discloses a system of dynamically and asynchronously reloading and updating Web page content. To perform this function, a reference to a "slow-loading" content element, such as an image, a video, or audio content, is included in the markup language specification of Web content (e.g., an HTML page). The slow-loading aspect of the content element allows a connection to remain open between a client and server. Using the open connection, the server can detect when a "dirty bit" is set, which indicates that the page needs to be reloaded or updated. The page also refreshes when the slow-loading content has finished loading, thus preventing a memory leak. The content can be an image element of zero width and height so as to preclude the image from actually appearing in the GUI. Col. 7, line 64 to col. 9, line 33.

In short, Joshi discloses a system that continuously reloads and updates a web page, no document in fixed or static form is finally output, the web page remains dynamic after the alleged resolving step.

In contrast, the present invention relates to the creation of documents (such as contracts, forms, user manuals, instructional texts, and others) by assembling document components and applying precedence and rules. Specification, ¶¶ 6-7, 10. A front-end system outputs transaction information to a document assembler, which creates documents based on the transaction information, rules, and precedence. Id. The completed and assembled document(s) are resolved to an XML file, style sheets or other formatting is applied, and an output file (or document) is generated. Id. at ¶ 42 and figure 1.

As is readily apparent, embodiments of the invention are distinct from the Joshi reference by their objectives, results, and means to achieve both. Unlike the Joshi reference, the claimed subject matter creates a static output file; that is, once the final output file is created, the file is not to be altered. Id. For instance, if a loan or mortgage document is generated, the terms are to be static over the duration of the document's existence. In stark contrast, the Joshi reference discloses a dynamic web page that continues to be updated or re-loaded as it is displayed on a web browser by way of a slow-loading reference embedded in the markup language of the web page. Joshi, abstract.

The Examiner is reminded that the MPEP requires determining "the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest *reasonable* construction in light of the specification as it would be interpreted by one of ordinary skill in the art." MPEP § 2111 (emphasis added) (*citing Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005)). Furthermore, "[t]he broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach." MPEP § 2111 (*citing In re Cortright*, 165 F.3d 1353, 1359 (Fed. Cir. 1999)).

Applicant believes the Examiner's interpretation of the claim language, particularly the term "resolving," is not consistent with the interpretation that those skilled in the art would provide. Rendering content on a browser and dynamically updating the rendered content is distinct from the claimed step of "resolving." Resolving a dynamic document structure as

claimed and disclosed requires all information to be known, with no additional data being considered after the resolving. For example, figure 1 shows that a fully resolved XML file is formed at box 40, thereafter a style sheet is applied and a file in static form is output. However, after the resolving step 40, no new data may be added to the document content. Joshi, however, continuously updates content using a slow-loading reference. Joshi, figure 5 and abstract. In light of the specification, one of ordinary skill in the art would not find any portion of the Joshi disclosure to be equivalent to "resolving ... a dynamic document structure." Rather, one of ordinary skill in the art would appreciate that Joshi is dynamically updating rendered content using a browser and slow-loading reference.

More particularly, Joshi fails to disclose each claimed element called for in claim 1, including "creating a transaction data set; ... configuring each dynamic document structure ... to resolve to one or more instances of a document[,] and resolving, with a computer processor and in accordance with the transaction data set, at least one dynamic document structure by executing the one or more embedded rules to create a specific instance of a document in a static form."

As the Examiner admitted in regard to claim 16, Joshi fails to disclose "creating a transaction data set." Office action mailed 1/18/08, p.9. In turn, as Joshi fails to disclose a transaction data set, it also fails to disclose or suggest "resolving, *in accordance with the transaction data set*, at least one dynamic document structure." In the present invention, an end-user may enter transaction data 61, which is then used in document assembly. Specification ¶ 63 and figure 4A. The assembly facility 30 and database 54/120, via application of the rules, can then use the transaction data to generate content for the document. Id. at ¶¶ 92-94 and fig. 4A.

In addition, Joshi fails to disclose "resolving ... at least one dynamic document structure ... to create a specific instance of a document *in a static form*." The Examiner contends that the step of resolving occurs by "retrieving the actual document content (i.e. actual image) that is outside of the document and plac[ing] the content within the document when it is retrieved; therefore resolving an instance of the document by executing the embedded rule included in the document content (reference within the markup syntax)." Office action mailed 1/18/08, p.5. Even assuming, arguendo, that Examiner's contention is correct, the resulting "resolved" document remains dynamic; that is, the reference embedded remains active, causing reloading and updating of the web-page. Joshi, figure 5. This resulting, dynamic page shown in the

browser and containing a slow-loading reference is distinct from the claimed "specific instance of a document in a static form."

Accordingly, for at least the foregoing reasons, Applicant respectfully requests withdrawal of the rejection of claim 1. Claims 12 and 13 depend from claim 1 and are allowable based upon claim 1 and upon other features and elements claimed in claims 12 and 13, but not discussed herein. Withdrawal of the 35 U.S.C. § 102 rejections of claims 12 and 13 is therefore respectfully requested.

III.   Claims Rejections – 35 U.S.C. § 103(a)

Claims 2-11, and 14-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Joshi in view of printed publication "XML in a Nutshell" authored by Harold et al. (hereinafter referred to as "Harold").

Claims 2-11 depend from claim 1 and for at least the reasons set forth above with respect to claim 1, Joshi fails to disclose or suggest the limitations of claims 2-11. Furthermore, Harold does not remedy the deficiencies of Joshi with respect to claim 1, as Harold merely provides a description of XML. Withdrawal of the 35 U.S.C. § 103 rejections of claims 2-11 is therefore respectfully requested.

Similar to claim 1, claim 14 calls for "creating a transaction data set … and resolving at least one dynamic document structure, with a computer processor and in accordance with the transaction data set, by executing the one or more embedded rules embedded in the document content to create a specific instance of a document in a static form" and claim 15 calls for "creating a transaction data set … and resolving, with a computer processor and in accordance with the transaction data set, at least one dynamic document structure by executing the one or more embedded rules embedded in the document content to create a specific instance of a document in a static form." For at least the reasons set forth above with respect to similar limitations in claim 1, Joshi fails to disclose or suggest these limitations. Furthermore, Harold does not teach or suggest these limitations, as Harold merely provides a description of XML. Therefore, Applicant believes claims 14 and 15 are also allowable.

Claims 16-17 and 28-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Joshi in view of U.S. Patent 6,006,242 (herein referred to as "Poole"). Similar to claims 1, 14, and 15, claims 16 and 28 call for "creating a transaction data set," which the Examiner admitted is not taught by Joshi. The Examiner instead relies on Poole to teach "creating a transaction data set." The Examiner alleges that "it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have combined Joshi et al's method with Poole et al's disclosure since it would have provided a document production system that provides for a high degree of content re-use and a flexible inferencing capacity that dynamically determines content to be included in a document." Office action 1/18/08, p.10.

However, it would not have been obvious to combine Joshi with the teachings of Poole because Poole teaches away from such a combination. More particularly, Joshi discloses dynamically updating rendered content, such as content of a Web page. Joshi, abstract. In contrast, Poole is directed towards creating electronic or printable documents and forms that, after resolution, are no longer dynamic. Although Poole discloses "dynamic document construction," it is the construction that is dynamic, not the (post-construction) document. Poole, abstract. The document is to be used, for example, by lending institutions or insurance companies, which require non-dynamically updating documents for loans or insurance policies. Poole, background, col. 1-2. This conflicts with the specific goal of Joshi, which is to efficiently update rendered content using a slow-loading content element. Joshi, abstract. Therefore, the combination would not have been obvious to one of ordinary skill in the art.

Additionally, claims 16 and 28 call for "creating a specific instance of a document in a static form based on the transaction data set and the processing of the one or more cross-referenced document components. As discussed above with respect to claim 1, Joshi fails to disclose or suggest such a limitation. Furthermore, Joshi specifically teaches away from "creating a specific instance of a document in a static form" because, as stated above, the specific intent of the Joshi invention is to efficiently update rendered content using a slow-loading content element. See Joshi, abstract.

Finally, neither Joshi nor Poole discloses "retrieving one or more *cross-referenced* document components" or "processing the one or more *cross-referenced* document components in a processor." (Emphasis added). The present invention, however, stores objects along with

cross reference maps as shown in block 94 of figure 4. Specification, ¶ 61. Furthermore, the cross reference tables reduce or eliminate the requirement of having to open and interrogate each XML object prior to knowing if it needs to be included in the document. Id. at ¶71. This allows for parent-child relationship re-assembly without reading each component. Id.

Accordingly, for at least the foregoing reasons, Applicant respectfully requests withdrawal of the rejections of claims 16 and 28, and claims 17-27 and 29-30, which depend from claims 16 and 28, respectively.

IV.   Conclusion

In light of the above, Applicant believes that the application is in condition for allowance and respectfully requests that a timely Notice of Allowance be issued in this case. Applicant also requests that the Examiner telephone the attorneys of record in the event a telephone discussion would be helpful in advancing the prosecution of the present application.

Charge or credit Deposit Account No. 13-3080 with any shortage or overpayment of the above fee.

Respectfully submitted,
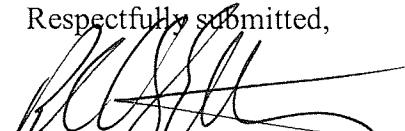
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